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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/507,124	09/10/2004	Holger Blum	KIRS.0013	8900
Reed Smith Suite 1400 3110 Fairview Park Drive Falls Church, VA 22042	7590 09/27/2007		EXAMINER RONESI, VICKEY M	
			ART UNIT 1714	PAPER NUMBER
			MAIL DATE 09/27/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/507,124

Applicant(s)

BLUM, HOLGER

Examiner

Vickey Ronesi

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION***Specification***

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the ranges of amounts of Component A (2-20 parts per 100 parts of aldehyde or 0.4-4 %) and Component B (0.5-8 parts per 100 parts of aldehyde resin or 0.2-2%) are not disclosed in the specification. Furthermore, the amounts in claims 2 and 3 are not disclosed in the specification.
2. The disclosure is objected to because of the following informalities: the formulae I and II should have the superscripts and subscripts already in it. Note that “R.sup.1” and R.sup.2” are incorrect given that “Rsub. 1” and “Rsub.2” are in the formulae. Furthermore, formula (I) causes confusion because it looks as though the aluminum is attached to the acetoacetate group via the methyl group and —CO—CH—CO— of the acetoacetate group should be $\text{—CO—CH}_2\text{—CO—}$.
3. The abstract of the disclosure is objected to because the formulae I and II should have the superscripts and subscripts already in it. Note that “R.sup.1” and R.sup.2” are incorrect given that “Rsub. 1” and “Rsub.2” are in the formulae. Furthermore, formula (I) formula (I) causes confusion because it looks as though the aluminum is attached to the acetoacetate group via the methyl group and —CO—CH—CO— of the acetoacetate group should be $\text{—CO—CH}_2\text{—CO—}$. Correction is required. See MPEP § 608.01(b).

Claim Objections

4. Claims 1-4 and 6 are objected to because of the following reasons:

With respect to claim 1, the formulae I and II should have the superscripts and subscripts already in it. Note that “R.sup.1” and R.sup.2” are incorrect given that “Rsub. 1” and “Rsub.2” are in the formulae. Furthermore, —CO—CH—CO— of the acetoacetate group should be $\text{—CO—CH}_2\text{—CO—}$

With respect to claim 1, line 5, the comma before “or” should be deleted.

With respect to claim 1, line 7, the comma before “or” should be deleted.

With respect to claim 1, line 7, “0,5” should be replaced with “0.5”.

With respect to claim 1, line 12, “formulae” should be replaced with “formula” because only one formula has an X group.

With respect to claims 2-4 and 6, the term “said additive Component [A or B]” lacks full antecedent basis because Component [A or B] does not have the term “additive” recited in the independent claim 1. Given that it is clear to what the term refers, no 35 USC 112, 2nd paragraph rejection is given.

With respect to claim 4, line 5, “0,4% should read as “0.4%”.

With respect to claim 4, line 8, “0,5%” should read as “0.5%”.

With respect to claim 6, line 8, “0,2%” should read as “0.2%”.

With respect to claim 6, line 10, “0,5%” should read as “0.5%”.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 1, formula (I) causes confusion because it looks as though the aluminum is attached to the acetoacetate group via the methyl group. If this is not the case, it is not made clear to what in the acetoacetate group the aluminum is bonded.

With respect to claim 1, the amounts of Components A and B do not have a basis (i.e., are the amounts based on weight, volume, moles?)

With respect to claims 2 and 3, the term "The paint or paint base" at the beginning of the claim lacks antecedent basis.

With respect to claims 2 and 3, the term "said fiber-reinforced aldehyde resin" lacks antecedent basis because only the paint is reinforced.

With respect to claim 4 and 6, the terms "said Aluminium di-sec-alkoxide acetoacetic ester chelate" and "said monoalkoxy organo-titanate-IV" lack antecedent basis given that it is an independent claim. Furthermore, the phrase "as defined in Claim 1" should be removed had Components A or B been defined properly.

With respect to claim 5, the claim is outside the scope of claim 4 given that claim 5 states "thereafter" in regards to the order of the steps.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1 and 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ichikawa et al (US 6,284,433).

Ichikawa et al discloses a heat-sensitive layer comprising 1-200 parts by weight (pbw) of metal-containing organic compounds including mixtures (col. 8, lines 1-9) of aluminum compounds such as aluminum di-sec-butoxide ethylacetoacetate (col. 6, lines 4-34) and titanium compounds such as isopropyltri(dioctyl phosphate) titanate (col. 6, lines 35-67); and 100 pbw hydroxyl group-containing compounds such as phenolformaldehyde novolak resins (col. 8, lines 20-51); and pigments (col. 3, lines 44-65). Note that fibers are not positively recited in the claim language given that it is only in the preamble. Given that the amount of metal-containing organic compounds overlaps with the range presently claimed and further given that Ichikawa et al teaches mixtures, it would have been obvious to one of ordinary skill in the art utilize the amounts of each in the composition like presently claimed.

Ichikawa et al does not explicitly disclose or exemplify a combination of di-sec-butoxide ethylacetoacetate, isopropyltri(dioctyl phosphate) titanate, and phenolformaldehyde resin

While Ichikawa et al does not exemplify a combination of di-sec-butoxide ethylacetoacetate, isopropyltri(dioctyl phosphate) titanate, and phenolformaldehyde resin, this does not negate a finding of obviousness under 35 USC 103 since a preferred embodiment such

Art Unit: 1714

as an example is not controlling. Rather, all disclosures "including unpreferred embodiments" must be considered. *In re Lamberti* 192 USPQ 278, 280 (CCPA 1976) citing *In re Mills* 176 USPQ 196 (CCPA 1972). Therefore, it would have been obvious to one of ordinary skill in the art to utilize a combination of di-sec-butoxide ethylacetoacetate, isopropyltri(dioctyl phosphate) titanate, and phenolformaldehyde resin given that Ichikawa et al teaches each one.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

9/20/07

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Application/Control Number: 10/507,124

Page 7

Art Unit: 1714

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